UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,840	02/15/2001	Yakov Kamen	ISURFTV114	3827

52940 7590 10/31/2008

HOLLAND & KNIGHT LLP
Attn: Stefan Stein/IP Dept
131 S. DEARBORN STREET
30TH FLOOR
CHICAGO, IL 60603

EXAMINER	
BAUTISTA, XIOMARA L	

ART UNIT	PAPER NUMBER
2179	

MAIL DATE	DELIVERY MODE
10/31/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YAKOV KAMEN and LEON SHIRMAN

Appeal 2008-1450
Application 09/784,840[1]
Technology Center 2100

Decided: October 30, 2008

Before JOSEPH L. DIXON, JEAN R. HOMERE, and THU A. DANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 4, and 6 through 11. Claim 5 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

---

[1] Filed on Feb. 15, 2001. The real party in interest is Eagle New Media Investments, LLC.

The Invention

Appellants invented a method and apparatus for creating a three dimensional browser to navigate video data in a virtual three-dimensional space. (Spec. 3.) As depicted in Figure 2, upon receiving uniform resource locators (URL) identifying information video data on the Internet, a format converter (110) transforms the received video data into a corresponding plurality of textures or two-dimensional images. (Spec. 7.) The 2-D images are subsequently forwarded to a pipeline (40) for projection onto a 3-D screen, thereby mapping the 2-D images onto a 3-D object. (*Id.*)

Independent claim 1 further illustrates the invention. It reads as follows:

1. A computer-implemented method for creating a three-dimensional navigation of a virtual three-dimensional space comprising:

associating a plurality of uniform resource locators obtained from a video presentation into a corresponding plurality of textures; and

mapping the textures on geometric surfaces which define a three-dimensional space.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Dalal	US 6,363,404 B1	Mar. 26, 2002 (filed Jun. 26, 1998)
Suzuki	US 6,611,262 B1	Aug. 26, 2003 (filed Sep. 11, 1998)

Rejection

The Examiner rejects the claims on appeal as follows:

Claims 1 through 4, and 6 through 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Suzuki and Dalal.

Appellants' Contentions

Appellants argue that Suzuki and Dalal are not properly combined to teach mapping URL-designated textures on 3D geometric surfaces. (App. Br. 4-5.) Particularly, Appellants argue that there is insufficient rationale for combining the cited references as suggested by the Examiner. (*Id.* 4.) Further, Appellants argue that Dalal teaches away from the claimed invention since it does not teach a URL obtained from a video presentation associated with textures that are mapped on the 3D surfaces. (*Id.* 5.)

Examiner's Response

In response, the Examiner finds that both Suzuki and Dalal teach using VRML to map URL-designated images in a video file onto surfaces of a 3D object. (Ans. 7-11.) Therefore, the Examiner concludes that the combination of Suzuki and Dalal renders claim 1 unpatentable. (*Id.*)

II. ISSUE

Thus, the pivotal issue before us is whether one of ordinary skill would have found sufficient rationale to combine Suzuki and Dalal's

teachings to yield the mapping of URL-designated textures on 3D geometric surfaces, as recited in independent claim 1. We answer this inquiry in the affirmative.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Suzuki

1. Suzuki discloses a method and system for recording a moving 2-D picture signal, for reproducing and displaying it on a 3-D object using a Virtual Reality Modeling Language (VRML). The 3D object is characterized as a plurality of nodes, each having 3-D coordinates. (Col. 1, ll. 10-12, ll. 43-55)

2. Suzuki further discloses that in VRML, it is possible to attach texture information of the moving picture in the nodes of the 3D object. (Col. 1, l. 63- col. 2, l. 5.)

3. Suzuki additionally discloses using a URL to designate the location of the moving picture file to be attached as texture with the 3D object. (Col. 7, ll. 46-48, col. 8, ll. 20-23, col. 11, ll. 20-24.)

Dalal

4. Dalal discloses a method and system for mapping composite documents (images and text) in 3-D models using VRML. Particularly, Dalal discloses using URLs to designate 2D grid texture images (e.g., a

movie file containing a series of texture images or frames) to cover the specified surfaces of the 3D models. (Col. 1, ll. 11-46.)

IV. PRINCIPLES OF LAW

Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) wherein evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might

be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007)). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR*, 127 S. Ct. at 1742.

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41. *See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006).

V. ANALYSIS

As correctly pointed out by the Examiner, we find that both Suzuki and Dalal disclose using VRML to map image textures in a video file, as designated by associated URLs, to corresponding surfaces of a 3D object. (FF. 1-4.) One of ordinary skilled in the art would readily recognize that Suzuki and Dalal disclose prior art elements that perform their ordinary

functions to predictably result in mapping of URL-designated textures on 3D geometric surfaces. We therefore agree with the Examiner that the combination of Suzuki and Dalal is proper. For these same reasons, we find Appellants' argument that Dalal teaches away from the invention to be unpersuasive.

Further, as set forth in the Findings of Facts section, we find that either Suzuki or Dalal reasonably teaches all the limitations of claim 1.

It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Suzuki and Dalal renders independent claim 1 unpatentable.

Appellants separately argue claims 2 through 4 and 6 through 11. However, Appellants repeat in great substance the same arguments offered for claim 1 above. Therefore, we sustain the Examiner's rejection for the same reasons articulated above in our discussion of claim 1.

VI. CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in concluding that the combination of Suzuki and Dalal renders claims 1 through 4, and 6 through 11 unpatentable under 35 U.S.C. § 103 (a).

VII. DECISION

We affirm the Examiner's decision rejecting claims 1 through 4, and 6 through 11 as being unpatentable under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

HOLLAND & KNIGHT LLP
Attn: Stefan Stein/IP Dept
131 S. DEARBORN STREET
30TH FLOOR
CHICAGO IL 60603